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EXAMINER	
LOFTIS, JOHNNA RONEE	
ART UNIT	PAPER NUMBER
3624	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/603,061	KRISHNAMURTHY ET AL.	
	Examiner	Art Unit	
	JOHNNA R. LOFTIS	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1/2/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is office action upon examination of application number 10/603061. Claims 1, 5, 6, 8-11 and 15 have been amended. Claims 1-15 are pending and have been examined on the merits discussed below.

Response to Arguments

2. Applicant's arguments, with respect to previous rejections under 35 USC 112 have been fully considered and are persuasive. The rejections under 35 USC 112 of the claims have been withdrawn.

3. Applicant's arguments filed with respect to previous rejections under 35 USC 101 have been fully considered but they are not persuasive. In order for a claim to be statutory under 35 USC 101, it must pass the "machine-or-transformation test" as laid out in the memo dated January 7, 2009. A mere field of use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test. In the instant case, merely storing data is considered insignificant extra-solution activity and further, the phrase "using the data processing system" is not clear. It cannot be determined exactly what steps are performed by the computer. A suggestion by the examiner is to amend the claim to

recite, "averaging, by the data processing system, the ratings..." Please make appropriate corrections.

4. In the previous Office Action mailed 7/2/08, notice was taken by the Examiner that certain subject matter is old and well known in the art. Per MPEP 2144.03(c), these statements are taken as admitted prior art because no traversal of this statement was made in the subsequent response. Specifically, it has been taken as prior art that: it would have been obvious to one of ordinary skill in the art to substitute averaging of a score for a sum of scores, as set forth in the rejections to the claims.

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. Applicants arguments regarding the calculation of percentages has been addressed by the new grounds of rejection set forth below. Since Macken teaches calculating the number of full time employees (FTE), examiner takes notice that it would have been obvious to calculate a percentage of FTE, since Macken determines the number of employees to be migrated (pp 0041). The determination of the number of employees to migrate, i.e., 50 from Jan through Sept and 60 from Oct through Dec, is easily converted to a percentage and it would have been obvious to one of ordinary skill in the art to do so. See rejections below.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-5 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must

(1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

8. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1-5 are non-statutory since they may be performed within the human mind.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-15 rejected under 35 U.S.C. 103(a) as being unpatentable over Macken, JR. et al, US 2003/0055697.

As per claim 1, Macken teaches collecting application data and storing the application data in a data processing system as a plurality of entries in an application inventory (para. 0037 - questionnaire is distributed according to the process migration template); assigning ratings for each of the entries according to a plurality of assessment factors, and storing the assigned ratings in the data processing system (para. 0039 – each scorecard includes a number of factors that are rated); averaging the ratings to determine an average rating using the data processing system (para. 0039 – overall score is computed). While Macken teaches determining the number of employees to be migrated to a second location (para 0041), it is not explicitly taught that employee migration percentages are determined. Examiner takes official notice that it would have been obvious to one of ordinary skill in the art to calculate a percentage of employees based on the numbers determined in Macken. Since the reference determines the number of employees to be migrated, it would be beneficial to calculate the percentage of employees that number represents as a way to more clearly evaluate the migration situation. While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 2, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 3, Macken teaches applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 4, Macken teaches determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 5, Macken teaches several factors involved in the calculations wherein the factors are rated (para. 0039-0042). While Macken teaches an overall score is calculated, Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious. While Macken teaches several factors involved in the calculations, the reference does not expressly teach the specific data recited in the claim; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see*

In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ∋ 2106.

As per claim 6, Macken teaches a data processing system (para. 0024) receiving and storing application data as a plurality of entries in an application inventory (para. 0037 - questionnaire is distributed according to the process migration template); receiving and storing ratings according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated). While Macken teaches determining the number of employees to be migrated to a second location (para 0041), it is not explicitly taught that employee migration percentages are determined. Examiner takes official notice that it would have been obvious to one of ordinary skill in the art to calculate a percentage of employees based on the numbers determined in Macken. Since the reference determines the number of employees to be migrated, it would be beneficial to calculate the percentage of employees that number represents as a way to more clearly evaluate the migration situation. While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 7, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 8, Macken teaches a data processing system (para. 0024) configured to applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 9, Macken teaches a data processing system (para. 0024) configured to perform the step of determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 10, Macken teaches several factors involved in the calculations wherein the factors are rated (para. 0039-0042). While Macken teaches an overall score is calculated, Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious. While Macken teaches several factors involved in the calculations, the reference does not expressly teach the specific data recited in the claim; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the

structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP э 2106.*

As per claim 11, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for collecting application data as a plurality of entires in an application inventory (para. 0037 - questionnaire is distributed according to the process migration template); receiving ratings for each of the entries according to a plurality of assessment factors (para. 0039 – each scorecard includes a number of factors that are rated). While Macken teaches determining the number of employees to be migrated to a second location (para 0041), it is not explicitly taught that employee migration percentages are determined. Examiner takes official notice that it would have been obvious to one of ordinary skill in the art to calculate a percentage of employees based on the numbers determined in Macken. Since the reference determines the number of employees to be migrated, it would be beneficial to calculate the percentage of employees that number represents as a way to more clearly evaluate the migration situation. While Macken teaches generating an overall score based on the ratings (para. 0039 and figure 4), the reference does not explicitly teach calculating an average rating. Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of

scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious.

As per claim 12, Macken teaches the assessment factors include at least one factor selected from the group consisting of client interface, technology, application management, and application category (para. 0040 – a technology questionnaire is used).

As per claim 13, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for applying weightings to the ratings (para. 0039 – each rating factor corresponds to a weighting, i.e., "0" corresponds to a difficult migration).

As per claim 14, Macken teaches a computer program product tangibly embodied in a computer-readable medium (para. 0026) comprising instructions for determining employee migration figures by multiplying the employee percentages by the number of full time equivalent employees (para. 0041 – the template determines the percentage of employees that will be used at the second location).

As per claim 15, Macken teaches several factors involved in the calculations wherein the factors are rated (para. 0039-0042). While Macken teaches an overall score is calculated, Examiner takes official notice that it is old and well known to average scores as an evaluation tool. Since each methodology are known in the prior art, the difference between the claimed subject matter and the prior art rests not on any individual methodology but in the very combination itself – that is in the substitution of the averaging of scores for the sum of scores. Thus, the simple substitution of one known methodology for another producing a predictable result renders the claim obvious. While Macken teaches several factors involved in the

calculations, the reference does not expressly teach the specific data recited in the claim; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP ∋2106.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Bayat can be reached on 571-272-6636. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jl/
1/15/09

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624